

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#20

In re Application of: CAZIN, D.

Attorney Docket No: 43869.017400

SERIAL NO.: 09/402,702

Group Art Unit: 2622

FILED: October 6, 1999

Examiner: NGUYEN, M.



FOR: FAX MACHINE FOR A COMPUTER NETWORK SUCH AS THE INTERNET

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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APPEAL BRIEF

OFFICE OF PETITIONS

Sir:

This is an appeal from the final rejection of claims 1 and 3 to 7 which are all of the claims pending in this application.

REAL PARTY IN INTEREST

This application is assigned to Sagem SA.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF THE CLAIMS

The instant application was filed containing original claims 1 to 7. In the amendment filed on June 17 2003, claim 2 was cancelled and claim 1 was amended. Pending claims 1 and 3 to 7 are the claims on appeal in this appeal. A copy of the pending claims is attached as appendix A, hereto.

STATUS OF AMENDMENTS

Appellant's response to the final rejection has been entered by the Examiner.

SUMMARY OF THE CLAIMED SUBJECT MATTER

In this summary all reference numbers refer to Figures 1 and 2, wherein the same numbers are used to represent the same elements. Figure 1 represents an operational block diagram of the fax machine of the invention and Figure 2 represents a diagram of the networks to which the fax machine in Figure 1 is connected. See page 2, lines 22 to 26.

The invention defined in independent claim 1 of the present invention relates to a fax machine (14). See page 3, lines 7 to 12. The fax machine is designed to be connected to a telephone network (100) and to communicate with a corresponding fax machines (15) across a computer network of the Internet-type (101). See page 2, lines 28 to 32. The fax machines (14,15) each have an electronic address on the aforesaid computer network (101, See page 2, lines 28 to 32), characterized by the fact that it has memory means (10) for storing a record (11) of the fax machine communications with the corresponding fax machines, containing electronic addresses of the aforesaid corresponding fax machines. See page 4, lines 19 to 21 and page 4, line 29 to page 7, line 13. The fax machine includes means (9) for managing the record (11), for extracting the electronic addresses and associating them with the corresponding fax machines, and means for asking a corresponding fax machine (15) for its electronic address, during a communication with the aforesaid corresponding fax machine (15) across the telephone network (100). See page 7, line 15 to 16, page 8, lines 6 to page 9, line 18, The means for managing the record (11) is adapted for entering the aforesaid electronic address of the corresponding fax machine (15) into the record (11). Page 7, lines 8 to 14. The fax machine in which, means (1,2) being provided to receive a fax transmitted from a corresponding fax machine (15) across the aforesaid network (101) and associated with the electronic address on the computer network of the said corresponding fax machine (15) see page 3, lines 6 to 22, the means (9) for managing the

record (11) are organized, upon receipt of the fax, to enter the electronic address of the aforesaid corresponding fax machine (15), into the record (11). Page 7, line 20 to page 9, line 1.

Identification of means plus function in involved independent and dependent claims

Independent claim 1 recites the following means plus function:

- memory means (10) for storing a record (11) of the fax machine communications with the corresponding fax machines, containing electronic addresses of the aforesaid corresponding fax machines. See page 4, lines 19 to 21 and page 4, line 29 to page 7, line 13.
- means (9) for managing the record (11),
- means for asking a corresponding fax machine (15) for its electronic address, during a communication with the aforesaid corresponding fax machine (15) across the telephone network (100). See page 7, line 15 to 16, page 8, lines 6 to page 9, line 18,
- means (1,2) being provided to receive a fax transmitted from a corresponding fax machine (15) across the aforesaid network (101) and associated with the electronic address on the computer network of the said corresponding fax machine (15). See page 3, lines 6 to 22.

Dependent claim 3 of the present invention recites the following means plus function:

- means (1,2) being provided to send to a corresponding fax machine (15) via the computer network (101), a fax associated with the electronic address on the computer network of the corresponding fax machine. Page 7, line 20 to page 9, line 1.

Dependent claims 4 to 7 of the present invention recite as means plus function the means for managing the record as described in claim 1.

The invention defined in dependent claim 7 of the present invention recites as means plus

function the memory means as described in claim 1.

GROUND OF THE REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 3 to 7 stand rejected under 35 USC § 102 (e) as being anticipated by U.S. Patent No. 6,157,706 (Rachelson).

ARGUMENT

Claim 1 is not anticipated by Rachelson

Rachelson's mail server is not a fax machine as recited in claim 1

Rachelson is directed toward a path between a computer and a fax; it fails to teach the managing means (9) of Applicants claim 1. (See Rachelson at column 13, lines 14 to 38.) On page 3, lines 8 to 14 of the January 23, 2004 Advisory Action (Advisory Action), the Examiner contends that the mail processing agent of 202 of FIGS. 2 and 3 can be interpreted as a fax machine since it includes a fax board, citing to Rachelson at column 6, lines 1 to 18. The Examiner then argues that that these features are implemented in similar fashion to the fax server 200, SMTP server 204 and EPOs 112, 142, 152.

To constitute an anticipation, all the claimed elements must be found in exactly the same situation and united in the same way to perform the identical function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Indus., Inc.*, 726 f.2d 724, 726, 220 U.S.P.Q. 841, 842 (Fed. Cir. 1984); *Integra LifeSciences I Ltd. v. Merck KgaA*, 1999 WL 398180, *398180, 50 U.S.P.Q.2d 1846, 1848 (S.D.Cal. 1999), *aff'd* 66 USPQ2d 1865 (Fed. Cir. 2003).

In Rachelson, element 202 of FIGS. 2 and 3 consists of a mail processing agent. As is perfectly clear in the figure, it is not a fax machine (see e.g. Element 110). Nor, as the Examiner alleges, does Rachelson teach or suggest that the mail processing agent has a fax board, although the presence or absence of a fax board does not render the computers described in Rachelson into

the fax machine recited in claim 1. Column 6, lines 15 to 18 of Rachelson, cited by the Examiner, states “the EPOs (electronic post office) of FIG. 1 each include a database, as described further below, and have voice boards, fax boards, and call processing software to control their software.” The sentence unambiguously refers to the EPO’s of FIG. 1, not to FIG. 3. It is in the previous paragraph at column 6, lines 1 to 6, that Rachelson states, “FIG. 3 is a block diagram of a computer system used in accordance with the embodiment of FIG. 1. Although FIG 3 shows an implementation of the mail processing agent 202 a person of ordinary skill in the art will appreciate that fax server 200, SMTP server 204 and EPOs 112, 142, 152 are implemented in a similar fashion”. Nothing in of FIG. 3, which shows an implementation of the mail processing agent 202, teaches or suggests that there is a fax board in the block diagram if FIG. 3. The mail processing agent 202 is not an EPO, and neither mail processing agent 202 nor the EPO is a fax machine as recited in claim 1.

Indeed, Rachelson itself makes a distinction between a computer and a fax machine, noting severally that many people have access to fax machines but not to computers (since it is directed toward enabling a facsimile machine to be an e-mail client). See column 1, lines 31 to 50; lines 11 to 18. None of the servers or EPOs are a fax machine as recited in claim 1.

In conclusion, Rachelson is not directed toward the improved fax machine recited in claim 1. This claimed element is not found in exactly the same situation and united in the same way to perform the identical function in a single unit in Rachelson. As a result, the reference does not teach or suggest “fax machines...characterized by the fact that it has, means for managing the record” as recited in claim 1.

The call processor of Rachelson cannot be means for managing the record

Building upon the incorrect premise that the agent 202 is a fax machine, the Examiner goes on to argue that this mail processing agent 202 includes a call processor that manages the records, extracts electronic addresses, and associates them with corresponding fax machines. For this he cites to column 8, lines 4 to 28 and column 13, lines 14 to 38 and states that the processor manages and controls the address book within the system.

The call processor as cited by the Examiner and described in Rachelson at column 13, lines 14 through 48, is an element of Rachelson's EPO, as shown at FIG. 13, element 1309 and column 11, lines 41 to 43. As established, the EPO is neither a mail processing agent nor a fax machine. Further, Rachelson's call processor itself distinguishes calls for an Interactive Voice Response (IVR) in the EPO from incoming calls from a fax machine (see column 13, lines 5 to 13). Rachelson does not teach or suggest that a fax machine includes means for managing the record.

Rachelson's address book is not memory means for storing a record

As regards column 8, lines 4 to 25 of Rachelson, this describes the "address book" feature of FIGS. 5, and 9(a) and 6. The Examiner states that the address book of the IVR "is the memory means which stores the record of communications, being corresponding dialed numbers and e-mail addresses." See Advisory Action, page 3, line 19 to page 4, line 1. The Examiner fails to point to any element that would be regarded as memory means, as the address book is not itself a memory means. Assuming without conceding that the record of communications is "corresponding dialed numbers and e-mail addresses" as the Examiner alleges, such an interpretation conflates a record with the memory means for storing a record since the address book would need to be both the record and the memory means at the same time. Claim 1 separately recites a record and memory means for storing a record. Nothing in Rachelson,

including the Examiner's citation at column 8, lines 4 to 28, teaches or suggests the recited memory means for storing a record included in a fax machine as recited in claim 1.

The address book is a part of a user telephone interface at the EPO; it is not any part of a user's fax machine. As described at column 7, line 26 to 40, a user places a voice call to an EPO. The EPO prompts the user using the IVR ("[u]sing the IVR, the user can perform activities such as entering e-mail addresses in his address book....", column 7, lines 36 to 40). The address book function of the menu described at column 8, lines 4 to 28 is at the EPO, not in the user's fax machine. Hence it cannot be that the address book is managed by a fax machine that includes the managing means or memory means as recited in the claim. It is neither in the mail processing agent 202 - as the Examiner argues - nor a user's fax machine (see e.g. Rachelson, FIG 2, 110).

Rachelson does not disclose asking a corresponding fax machine for its electronic address

Nor has the Examiner cited to anything in Rachelson which teaches or suggests means for asking a corresponding fax machine for its electronic address. At page 4, lines 6 to 15 of the Advisory Action, the Examiner cites to Rachelson's statement that each time e-mail is received by the user from someone who has previously not sent the user e-mail, the system automatically makes an entry in the address book. Rachelson column 8, lines 4 to 14. As is evident, Rachelson's EPO does no asking whatsoever; it is the passive recipient of an e-mail. Compare this to the present application where during a capacity interchange protocol, the fax machine asks the called fax machine whether it has the capacity to communicate on the internet and, if so, asks for its Internet address. (e.g.: page 8, line 27 to page 9, line 4).

As for the Examiner's column 13, Rachelson's call processor looks at a CSID (Customer Service ID) of the calling fax machine (again, as a passive recipient) or the calling fax machine can be identified by the caller ID number provided by the telephone company (if caller ID service

is available). The customer service ID is the code sent from a conventional sending fax machine that identifies the fax number of the sending fax machine. The call processor then determines the e-mail address of the intended recipient by looking up the dialed number (the DID or "Direct Inward Dialing" number) in the user's address book. As can be seen, the call processor in the EPO's IVR looks at a CSID or caller ID number - neither of which is an electronic address - of a fax machine calling it, and then looks up a number to determine the e-mail of the intended recipient in the user's address book. In short, a caller ID number or code is compared with a dialed number in the user's address book in the EPO to obtain an e-mail address. Nowhere in this sequence of events described in Rachelson is a corresponding fax machine asked for electronic address even by the EPO, much less the fax machine recited in claim 1.

Claim 3 is not anticipated by Rachelson

The Examiner's rejection of claim 3 is flawed since independent claim 1 recites a patentable invention and claim 3 depends off of claim 1. The Examiner also alleges that Rachelson "teaches of means being provided to send to a corresponding fax machine, via the computer network, a fax associated with the electronic address on the computer network of the corresponding fax machine (column 6, lines 45 through column 7, line 25), the means for managing the record are adapted to enter the electronic address of the aforesaid corresponding fax machine into the record prior to sending the fax, (see FIG. 6, column 8, lines 3 through 64)." See August 26, 2003 Office Action.

Rachelson discloses that Figures 4 (A) to 4(C), which correspond to the Examiner's citation of column 6, lines 45 through column 7, line 25, are block diagrams showing various paths taken by messages in that system. (Column 6, lines 45 to 46.) As pointed out in the Applicant's Response of December 23, 2003 (Response), Figures 4 (A) to 4(C) the present

invention as Rachelson relates to a path between a computer and a fax., or between two fax machines. See Response, page 5, 8 to 11.

The present application, when sending a fax to a corresponding fax machine, analyzes a fax image and appends it, in a mail, to the header of an electronic mail containing the electronic address of the corresponding fax machine. This is a fax-mail. By virtue of this, a fax can be transmitted entirely by internet. In FIGS. 4 (A) to 4 (C) of Rachelson, there is no fax to fax communication that occurs entirely over the internet (“I” in the Figures). Whenever there is direct communication to or from a fax machine, it must occur over a telephonic network (“T” in the Figures) network. This is because Rachelson teaches sending a fax to a remote location where it is converted into an e-mail, or sending an e-mail to a remote location from where it is converted into a fax message. For this reason Rachelson fails to teach or suggest means being provided to send to a corresponding fax machine, via the computer network, a fax associated with the electronic address on the computer network of the corresponding fax machine.

Claim 4 is not anticipated by Rachelson

Regarding claim 4, the Examiner alleged that Rachelson disclosed the fax machine discussed above in claim 1, and further teaches that since each electronic address contains identification data (see Rachelson Fig, 9(A), column 8, lines 15 through 28), the means for managing the record are organized to extract the aforesaid identification data from each address of a corresponding fax machine and to associate the data with aforesaid address in the record (Rachelson, column 8, lines 4 through 48). See also Advisory Action, page 4, lines 6 to 14.

As established, the Rachelson’s address book structure shown at Figure 9(A) and described at column 8, lines 15 through 28 is an IVR function of the EPO. Even if the “means

for managing the record” was taught or suggested by Rachelson’s address book, which is not the case, the address book is in an EPO, which is not the improved fax machine recited in claim 1.

Further, claim 4 recites that the means for managing the record are organized to extract the aforesaid identification data from each address of a corresponding fax machine and to associate the data with aforesaid address in the record. The present application states that the words “identification data” are intended to indicate the name which precedes the @ symbol in an Internet address. See page 7, lines 8 to 13. Nothing in Rachelson, including Figure 9 or the description the Examiner cites, shows how any means for managing the record organized are to extract the aforesaid identification data from each address of a corresponding fax machine.

The only active step performed by Rachelson’s system is if an e-mail is received by the user from someone who has previously not sent the user e-mail, the system automatically makes an entry into the address book. See Rachelson column 8, lines 4 to 14 and Advisory Action, page 4 lines 11 to 13. Nothing is extracted from the entry. Rachelson’s system determines to which e-mail address to send a message faxed by a particular user by first locating the address book for the current user and then by doing a lookup operation on the internet fax number dialed/entered by the user to send the fax. While Rachelson discloses that this internet fax number is a "unique code" identifying potential recipients of e-mail from the user, it is the user that enters it. Column 8, lines 21 to 29. There is no identification data extracted from each new electronic address of a corresponding fax machine, nor is there any associating any such data with any electronic address in the record.

None of Rachelson’s system functions teach or suggest how the address book is a means for managing the record organized to extract identification information from each electronic address of a corresponding fax machine, much less associate the data with the aforesaid address

in the record. Nothing cited in Rachelson shows how any data is extracted from any part of an electronic address, much less how it is associated with an address in the record.

Claim 5 is not anticipated by Rachelson

The Examiner has rejected claim 5, which depends off of claim 4, based upon the previous citation of Rachelson in claim 4 as well as column 13, lines 14 to 38. Contrary to his allegation, Rachelson neither here nor elsewhere teaches or suggests that the means for managing the record are organized to compare the identification data extracted from each new electronic address with the identification data associated with the electronic address stored in the record in order to check whether the aforesaid identification data is already associated with the electronic address in the record. There is no extracted identification data to compare with anything, hence it cannot be that such identification data is compared with "aforesaid identification data already associated with the electronic address in the record" as recited in claim 5.

As for the citation to column 13, Rachelson's call processor looks at a CSID (Customer Service ID) of the calling fax machine, or the calling fax machine can be identified by the caller ID number provided by the telephone company (if caller ID service is available). (See Advisory Action, page 4, lines 13 to 15). The customer service ID is the code sent from a conventional sending fax machine that identifies the fax number of the sending fax machine. The call processor then determines the e-mail address of the intended recipient by looking up the dialed number (the DID or "Direct Inward Dialing" number) in the user's address book. Each user's book has a plurality of e-mail addresses associated with a corresponding plurality of DID numbers. In short, a caller ID number is compared with a dialed number in the user's address book in the EPO to obtain an e-mail address. Neither the CSID, nor the DID, nor the caller ID are electronic addresses or are extracted from electronic addresses. See also Advisory Action,

lines 13 to 15. This process described in Rachelson has nothing to do with, nor teaches, nor suggests comparing the identification data extracted from each new electronic address with the identification data associated with the electronic address stored in the record, much less checking whether the aforesaid identification data is already associated with the electronic address in the record.

Claim 6 is not anticipated by Rachelson

With respect to claim 6, which depends from claim 5, the Examiner alleges that Rachelson discloses that the identification data extracted from the new electronic address is already associated with an electronic address in the record, the means for managing the record are organized to compare the electronic address held in the record with the new electronic address, and, where they are not identical, to replace the former record with the latter record. After reciting the claimed limitations of the present application thus, he simply cited to column 8, lines 29 to 48, without more. Office Action, page 4 line 21 to page 5 line 4. Yet this citation of Rachelson merely shows- and the Examiner has elsewhere admitted- that a user may add or remove e-mail addresses in an internet fax number of the user's address book. (See Office Action, page 5, lines 9 to 10). Assuming *arguendo* that an address book is a means for managing the record, which it is not, the mere fact that user may add or remove e-mail addresses hardly teaches or suggests that the means for managing the record are organized to compare the electronic address held in the record with the new electronic address, and, where they are not identical, to replace the former record with the latter record.

Claim 7 is not anticipated by Rachelson

As regards the rejection of claim 7, which depends from claim 6, the Examiner recites the limitations of that claim and again cites to the same disclosure in column 8 of Rachelson. (Office

Action, Page 5, lines 5 to 10). He argues that lines 15 to 19 “further teaches since the memory means have a limited storage capacity...”. Quite simply, there is no such disclosure, teaching or suggestion. Just as the arguments Advisory Action failed to identify a memory means in Rachelson, the cited text is a description of the format of Rachleson’s address book’s data structure- there are no memory means to be found, much less any indication of storage capacity.

The Examiner also states that a user removing a oldest address and adding a newer address teaches the recitation that “when the aforesaid memory means are full, the means for managing the record are organized to erase the oldest electronic address in the memory prior to entering a new electronic address” For this he cites to column 8, lines 15 through 19. As admitted by the Examiner, it is the user, and not the organization of the means for managing the record, that determines what is removed and added in Rachelson. Office Action, page 5, lines 9 to 10. Further, there is no reference whatsoever to a memory means, much less a full one. As discussed, Rachleson simply discloses an address book in an EPO’s IVR that a user can access to get, add or remove addresses.

CONCLUSION

Appellant urges for the reasons given above that the present claims are allowable over the applied prior art. The Examiner is requested to reconsider the §102 rejections and withdraw these rejections.

If the Examiner maintains these rejections, appellant respectfully request that the Board reverse the Examiner's §102 rejections.

Dated: November 24, 2004

Respectfully submitted,

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